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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,128	06/24/2003	Brian L. Wilt	KMC / 302US	1590
26875	7590	06/10/2004	EXAMINER	
WOOD, HERRON & EVANS, LLP			NGUYEN, THONG Q	
2700 CAREW TOWER			ART UNIT	
441 VINE STREET			PAPER NUMBER	
CINCINNATI, OH 45202			2872	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/602,128	<b>Applicant(s)</b> WILT ET AL.	
	<b>Examiner</b> Thong Q Nguyen	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/22/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings contain six sheets of figures 1-10 were received on 6/24/2003.

These drawings are objected by the Examiner for the following reason(s).

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In particular, the references "12a", "30a", and "34a" shown in figure 4A, and the references "50a", "54a" and "64a" shown in figure 4B are not mentioned in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In particular, the reference "74" mentioned in page 12 is not shown in at least one figure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

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requested in correcting any errors of which applicant may become aware in the specification.

5. The disclosure is objected to because of the following informalities: Page 13: line 20, "10b" should be changed to -10a-. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

1) Each of claims 1 and 10 recites a magnification loupe having a housing for supporting an eyepiece lens and an objective lens wherein the objective lens having a non-circular shape. However, the data relating to the diameter of the objective lens as provided in the specification does not provide support for the feature claimed. In particular, the table 2, page 11, provide optical data of the lens elements wherein the diameters of the objective lens element IV are the same for both dimension. As a result of data of the lens element IV, it is clear that the objective lens IV does not have a non-circular shape as claimed.

b) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiency thereof.

8. Claims 4-5 and 12-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnification loupe having a single eyepiece lens and a two element objective lens, does not reasonably provide enablement for a magnification loupe having lens elements as claimed. See further details provided below. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The device as claimed in the set of claims 4 and 12 and the device as claimed in the set of claims 5 and 13 does not have support/enablement in the specification. Applicant is respectfully invited to review the device as disclosed in the specification. In particular, the specification discloses two embodiments of the magnification loupe carried by a user wearable device as follow.

The first embodiment discloses a magnification loupe having a single eyepiece lens and a two-element objective lens wherein the loupe is pivotally connected to a spectacles having a pair of lenses. As shown in pages 7-9 and Table 1, the lens labeled as I is the lens of the spectacles, the lens labeled as II is the eyepiece lens and the lenses labeled as III and IV are the two-element objective lens. As a result, the lens structure as claimed in each of claims 4 and 12 does not matched with the lens structure of the magnification loupe which comprises

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only a single eyepiece lens and a two-element objective lens as taught in the specification in pages 7-9 and Table 1.

The second embodiment discloses a magnification loupe having a single eyepiece lens and a two-element objective lens wherein the loupe is mounted through the eyeglass lens element of a spectacles having a pair of lenses. Since the loupe is mounted through the eyeglass lens element of a spectacles; therefore, a correction lens is used. As shown in pages 9-12 and Table 2, the lens labeled as I is the lens of the correction lens, the lens labeled as II is the eyepiece lens and the lenses labeled as III and IV are the two-element objective lens. As a result, the lens structure as claimed in each of claims 5 and 13 does not matched with the lens structure of the magnification loupe which comprises only a single eyepiece lens and a two-element objective lens as taught in the specification in pages 912 and Table 2.

### ***Claim Objections***

9. Claims 4-5, 7-9, and 11-13 are objected to because of the following informalities. Appropriate correction is required.

- a) In each of claims 4 and 12: the last line of each claim: "the optical centerline" should be changed to --an optical centerline--.
- b) In each of claim 5, on line 14, and claim 13, on line 22, "D1, D2, etc. represent" should be changed to --D1 and D2 represent--. The reason of this suggestion is that the there are only D1 and D2 in the table disclosed the optical data of the lens elements. See Table in the column "Diameter"; and in each of

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claims 5 and 13, on last line of each claim, "the optical centerline" should be changed to --an optical centerline--.

c) In claim 7: on line 2, "may be" should be changed to --is--. The reason of this suggestion is that the use of the terms "may be" renders the claim indefinite because it is unclear whether the component(s)/function(s) appeared after such terms is/are positively component(s)/function(s) of the device claimed or not.

d) In claim 8: on line 2, "the spectacles" should be changed to --the (or said) user wearable device--. The reason of this suggestion is that the base claim 1 and claim 8 do not provide a proper antecedent basis for the feature "spectacles".

e) In claim 9: on line 3, "the spectacles" should be changed to --user wearable device--. The reason of this suggestion is that the base claim 1 and claim 9 do not provide a proper antecedent basis for the feature "the spectacles".

f) In claim 11, on line 3, "may be" should be changed to --is--. The reason of this suggestion is that the use of the terms "may be" renders the claim indefinite because it is unclear whether the component(s)/function(s) appeared after such terms is/are positively component(s)/function(s) of the device claimed or not; and on line 5, "the loupe" should be changed to --the (or said) viewer--. The reason of this suggestion is that the base claim 10 and claim 11 do not provide a proper antecedent basis for the feature "the loupe".

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 and 8-10, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Wada (U.S. Patent No. 4,865,438).

Wada discloses an optical device having a magnification loupe attached to an eyeglass. The device as described in columns 1-4 and shown in figures 1-2 and 4-5 comprises the following components: 1) An eyeglass having a frame (1) supporting a pair of prescription lenses (2) wherein the prescription lenses are able to change for a different set of prescription lenses based on intended use or working distance. It is also noted that the prescription lenses can select from a group of lenses having curved surfaces or non-curved surfaces. See column 2, lines 55-60; and 2) a magnification loupe (10) comprises a pair of monoculars (11) which are removably attached to the eyeglass frame via a mechanism (12). Each of the monoculars (11) comprises a housing (13) having a first end supporting a movable eyepiece lens (15) and a protective element (23) and a second end supporting an objective lens (14) and a protective element (17). The objective lens has a non-circular shape having two oppositely peripheral edges defined by a first radius from a first center, and the remaining two oppositely peripheral edges defined by a second radius extending from a second center not coincident with the first center wherein the second radius has a length different from the first radius. Applicant should note that a planar edge of a lens is understood as a surface having an infinite radius with its center is in infinite.



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Regarding to the feature relating to the connection of the magnification loupe to the eyeglass, it is noted that in columns 2-3, Wada discloses the use of a mechanism (12) for coupling the pair of the monoculars to the bridge of the eyeglass frame, and each lens (2) of the eyeglass has a bore for allowing the end of the housing of each monocular go through.

12. Claims 1, 3, 6, 8 and 10, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Feinbloom (U.S. Patent No. 3,273,456, submitted by applicant).

Feinbloom discloses an optical device having a magnification loupe attached to an eyeglass. The device as described in columns 1-3 and shown in figures 1-4 and 6 comprises the following components: 1) an eyeglass having a frame with a bridge (14) supporting a pair of lenses (16). It is noted that each lens of the eyeglass frame as shown in figure 2 has a non-curved surface; and 2) a magnification device comprises a pair of monoculars (18) which are removably mounted through a corresponding lens of the eyeglass. See figures 1-2.

Each of the monoculars (18) comprises a housing (20) having a first end supporting a single eyepiece lens (III) and a correction lens (22) and a second end supporting a two-element objective lens (I, II). The objective lens has a non-circular shape having two oppositely peripheral edges defined by a first radius from a first center, and the remaining two oppositely peripheral edges each defined by a second radius extending from a second center not coincident with the first center wherein the second radius has a length different from the first

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radius. Applicant should note that a planar edge of a lens is understood as a surface having an infinite radius with its center is in infinite.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom in view of Caplan et al (U.S. Patent No. 6,061,189, submitted by applicant).

The optical device having a magnification loupe coupling to an eyeglass as provided by Feinbloom does not explicitly state that the correction lens is able to replace with other correction lens of different optical characteristics for the purpose of varying a working distance. However, the use of a magnification loupe coupled to an eyeglass frame wherein the housing of the loupe supporting an eyepiece lens and a correction lens which lenses are able to replace with different set of eyepiece lens and correction lens for the purpose of varying working distances is known to one skilled in the art as can be seen in the through the lens binocular viewer provided by Caplan et al. See columns 4-5 and fig. 3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the optical device provided by Feinbloom by changing the correction lens whenever an eyepiece lens is changed as

suggested by Caplan for the purpose for adjusting the working distances as well as the contrast.

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom in view of Moore (U.S. Patent No. 5,900,922) or Koiwai et al (U.S. Patent No. 5,748,390).

The optical device having magnification loupe coupled to an eyeglass wherein the objective lens has a non-circular shape as provided by Feinbloom meets all of the limitations of the device as claimed in claim 2 except the feature relating to the shape of the lens. In particular, Feinbloom does not disclose that a set of peripheral edges of the lens has a semi-elliptical shape. However, the use of a non-circular shape for a lens is merely that of a preferred embodiment as admitted by the applicant as can be seen in the specification in page 13, section [0038] and figs. 4(A-B). It is also noted that the use of lens in an optical device wherein the device is an eyeglass or an imaging device which lens has an oval shape or an elliptical shape is known to one skilled in the art as can be seen in the device provided by either Moore, see column 2 and fig. 2, or Koiwai et al, see column 5. It is also noted that it was decided in the Courts that it have been an obvious matter of design choice to change the shape and generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art to modify the non-circular lens in the system provided by Feinbloom by making the

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configuration of the lens on a set of edges as an semi-elliptical configuration as suggested by Moore or Koiwai for the purpose of satisfying a particular design.

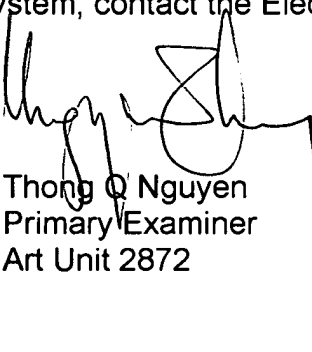
**Conclusion**

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen  
Primary Examiner  
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